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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,797	03/09/2001	Jon Marcus Randall Whitten	MS1-768US	8294

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EXAMINER
JONES, SCOTT E

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 08/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/802,797	RANDALL WHITTEN ET AL.	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 March 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-60* is/are pending in the application.

4a) Of the above claim(s) *53-56* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52 and 57-60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-60* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-52, and 57-60 are drawn to a game console having a processor and memory, classified in class 463, subclass 1.

II. Claims 53-56, drawn to memory management in a game console, classified in class 709, subclass 1 or class 711, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the memory management system claimed in not necessarily required for a game console having a processor and memory. The subcombination has separate utility such as managing memory for word processing application software on a personal computer.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper. During a telephone conversation with Lewis C. Lee, Reg. No. 34,656 on July 23, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-52, and 57-60. Affirmation of this election must be made by applicant in replying to this Office

action. Claims 53-56 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-9, 12-19, 21-22, 24-25, 27, 34-35, 43, 48, 50-52, 57-58, and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka (U.S. 6,299,535).

Tanaka discloses a method of processing an interactive game, a program product, and a game system which enables players to play video games. Tanaka discloses:

Regarding Claims 1, 13, 15, 22, 27, 34, 35, and 57:

a processor (**12**) (Fig. 1);

- a hard disk drive (**15**) coupled to the processor, the hard disk drive being configured to store various game data (Fig. 1, Column 3, lines 54-55, and Column 13, lines 9-18).

Regarding Claims 2, and 16:

- a memory (**13**) (**14**) coupled to the processor (Fig. 1).

Regarding Claim 3:

- a portable media drive (**18**) (**30**) coupled to the processor and configured to communicate with a storage disc (Fig. 1).

Regarding Claims 4, 17, 57, and 60:

- a console application stored on the hard disk drive and executable on the processor, the console application configured to implement a user interface to the gaming system (Column 3, lines 54-55, and Column 13, lines 9-18).

Regarding Claim 5:

- a portable memory unit (**31**) coupled to the processor (Fig. 1, and Column 4, lines 11-14).

Regarding Claims 6, 24, 27, 34, 35, 43, and 48:

- the hard disk drive is configured to store game data, audio data, and video data (Column 3, lines 53-54, Column 13, lines 9-18, and Column 5, lines 31-51).

Regarding Claims 7, 19, and 58:

- the hard disk drive is segregated into a plurality of regions, each region for storing a particular type of data (Column 3, lines 53-54, Column 13, lines 9-18, and Column 5, lines 31-51).

Regarding Claims 8, 18, 21, and 25:

- the hard disk drive is segregated into a user data region, an application region, and a console application region (Column 3, lines 53-54, Column 13, lines 9-18, and Column 5, lines 31-51).

Regarding Claim 9:

- the hard disk drive is segregated into a settings region, a user data region, an application region, a utility region, and a console application region (Column 3, lines 53-54, Column 13, lines 9-18, and Column 5, lines 31-51).

Regarding Claims 12, 13, 14, 43, 48, and 50-52:

- the game console boots into a console application stored on the hard disk drive. Inherently, computers have boot executable programs that have start-up routines upon providing power to a computer.

7. Claims 1, 10-11, 13, 20, 22-23, 26-33, 36-43, 44-49, and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Links 386CD Players Manual.

Links 386CD Players Manual discloses golf video game played on a game console (personal computer) having a hard disk drive and memory. Links 386CD Players Manual discloses:

Regarding Claims 10, 23, 45, and 49:

- the hard disk drive is configured to store data associated with multiple saved games (Page 45).

Regarding Claims 11, 26, 32, 33, 36, 37, 38, 39, 40, 42, and 44:

- retrieving, displaying, and allowing a user of the gaming system to select and/or create a nickname (player name) from/in the Player List Box (Page 19).

Regarding Claim 20:

- the hard disk drive is configured to store saved game data such that the saved game data associated with a particular game is stored separately from saved game data associated with other games (Pages 44-45).

Regarding Claim 41:

- automatically entering the selected nickname into a high score display (score card) (Page 28).

Regarding Claim 28:

- saving a current state of a game to the hard disk drive in response to a save game request (Pages 44-45).

Regarding Claims 29, 30 and 31:

- retrieving a list of saved games associated with the game installed in the gaming system (Pages 44-45).

Regarding Claims 46-47:

- the game console boots into a console application stored on the hard disk drive. Inherently, computers have boot executable programs that have start-up routines upon providing power to a computer.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and

useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Applicant is advised that should claim 58 be found allowable, claim 59 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mayer et al. '476, Niedawiecki '125, and Bouton '487, '701 discloses gaming systems having hard disk drives and memory.
- Dickinson et al. '485 discloses a high-score display system for a video game.
- Nielsen '067, and Sakaguchi et al. '862 disclose portable storage devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Scott E. Jones
Examiner
Art Unit 3713

SEJ
sej
July 24, 2002

V. Martin Wallace

VALENCIA MARTIN-WALLACE
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